

REMARKS

Responsive to the Examiner's inventorship query, all claimed subject matter was commonly owned at the time the inventions claimed therein were made. 37 C.F.R. § 1.56.

Rejection Under 35 U.S.C. 103(a)

Claims 1 and 3-15 stand rejected under 35 U.S.C. 103(a) as unpatentable over Maguire in view of Dawson. The Examiner's position is that Maguire teaches shaped blocks 10 with grooves 30 and knobs 32, so that respective grooves and knobs of successive blocks engage when blocks are stacked atop each other. The Examiner notes that Maguire discloses round knobs 32 (col. 3, line 9) and spaced grooves 30 (outboard of hole 18, Figs. 2-3). The respective round knobs 32, spaced grooves 30 and neck members of Maguire's blocks are said to be arranged so that planes parallel to a plane of symmetry for block 10 pass therethrough. Maguire is said to disclose that knobs 32 and grooves 30 eliminate pins, which can crack and destroy retaining walls (col. 4, lines 48-50). Dawson is said to disclose retaining wall blocks 10 with at least two pins, two pinholes 36, 38, and two pin pockets 40 (Figs. 1-2). Dawson is also said to teach (col. 7, lines 16-37) that an upwardly extending knob 46 (Figs. 9a, 9b, 11) is an alternative to a pin and hole connection. The Examiner concludes that it would have obvious to one of ordinary skill in the art to replace Maguire's round knobs with pins-in-holes in view of Dawson and Maguire teachings that pins-and-holes are alternatives for knobs and considered equivalent parts to perform equivalent functions.

As to claim 5, both Maguire and Dawson are said to teach a second set of alignment pins. As to claim 6, sidewall faces are said to taper inwardly. As to claim 7, notches to form weak links to break concrete blocks is said to be old and well known; it would have been obvious to provide Maguire's block with breaking

areas to break the block cleanly at a desired point. As to claims 12, 13 and 15, the incorporation of known retaining wall elements is said not to constitute allowable subject matter. It is said that Maguire could accommodate rebar, a post or a pilaster as an obvious design choice if one of ordinary skill in the art so desired.

Applicants respectfully traverse this rejection.

The present application has been remanded to the Examiner from the Board of Patent Appeals and Interferences. The Board directed the Examiner to “...determine whether it would have been obvious to one having ordinary skill in the art to replace the round knobs of Maguire with pins in holes, in light of the apparent recognition by Maguire and Dawson of pins and knobs as alternatives, taking into account, of course, that Maguire indicates that knobs eliminate the need for using pins.” (Decision on Appeal, p. 7). The Board further stated in a footnote that “[t]he statement by Maguire concerning eliminating the need for pins should be evaluated to determine whether it is a teaching away.” The Board provided further guidance by citing from In re Gurley, 27 F.3d 551, 553, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994) as follows:

A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

(Decision on Appeal, fn 2, p. 7)

In making the present claim rejections the Examiner has concluded that it “would have been obvious to one of ordinary skill in the art to replace the round knobs of Maguire with pins in holes in view of the teaching in Dawson and also in Maguire that pins and holes are alternatives for knobs and are considered equivalent parts for performing equivalent functions.” Applicants submit that in making this conclusion the Examiner has either ignored the direction of the Board to consider whether Maguire

teaches away from substituting a pin and hole for a knob or has failed to fully appreciate the extent to which Maguire's disclosure discourages such a substitution.

Although Maguire acknowledges that pins in holes can be used as a means of connecting blocks when Maguire is properly considered in its entirety it clearly teaches that pins and holes are not equivalent to knobs and that they do not perform equivalent functions. As a matter of fact one reading Maguire will recognize that Maguire expends considerable effort pointing out the deficiencies of prior art pin and hole connection systems and the consequent advantages over those systems of Maguire's knob and groove connection system. For example, Maguire teaches that "...pin connectors tend to shear flexible grid material rendering the wall structurally unsafe." Col. 4, lines 22 and 23. The larger Maguire knob elements are said to reduce shear stress by displacing shearing force over a larger area. Maguire teaches that this preserves the structural integrity of the grid material "...thereby improving the overall strength of the wall." Col. 4, lines 25 to 30. This disadvantage alone, which is directed to the stability and safety of a wall constructed from Maguire's blocks would be a significant consideration tending to discourage one of skill in the art from substituting a pin and hole for the knob in Maguire's block. However, Maguire provides additional reasons why knobs are superior to pins in holes.

Maguire further teaches that the use of pins should be avoided since pins "...can easily crack and destroy the retaining walls." Col. 4, lines 49 and 50. Maguire discloses that this problem is overcome by use of knobs and grooves which also provide increased strength. Col. 4, lines 46 to 51.

Maguire further points out the disadvantages of prior art pin and hole connection systems during construction of a retaining wall. Maguire criticizes these systems because they require "...significant on-site labor, careful alignment of the blocks as well as the securing of each block element with the aforementioned pins." Col. 1, lines 24 to 27. Maguire's knob and groove block, on the other hand, is said to be "...easily stacked to form a secure retaining wall with minimal labor and cost." Col. 1, lines 57 and 58.

A further disadvantage of prior art pin and hole block systems recognized by Maguire is the difficulty in storing and transporting them to a job site. Maguire points out that such blocks are difficult to strap and palletize and require excess handling to see that the blocks do not shift in travel. Col. 1, lines 35 to 42. Maguire's blocks may be stacked one on top of another with the knobs on the lower block engaging grooves on the lower surface of the upper block to form an interlocking arrangement. This interlocking of stacked blocks is stated by Maguire to insure secure stacking and palleting for shipment and travel. Col. 2, lines 11 to 22.

Applicants submit that the real issue that must be determined in deciding whether the pending claims are unobvious is not whether pin and hole connection systems were a well known means of connecting courses of blocks in a retaining wall. Clearly such systems were well known. Rather, the issue is precisely whether a person of skill would modify the particular blocks disclosed in Maguire by substituting a pin in a hole for the knob.

The disadvantages of pin in hole connection systems pointed out by Maguire would clearly direct one of ordinary skill away from substituting a pin in hole for the knob of the Maguire block. For one of ordinary skill to make this substitution one would have to ignore Maguire's teaching that

such a substitution would result in a block system that is more difficult to stack and pallet, more difficult and costly to ship, require more labor and time in constructing a retaining wall, and result in a retaining wall that is more likely to shear stabilizing grid material resulting in a wall that is structurally unsafe. Applicants submit that it is unreasonable to conclude that a person of skill with knowledge of the teachings contained in Maguire would modify the Maguire block in the manner necessary to support the Examiners rejection. Therefore, Applicants respectfully request that this rejection be withdrawn.

In remanding this application to the Examiner to consider the patentability of the claimed subject matter under 35 U.S.C. § 103(a) based on the present combination of the teachings of Maguire and Dawson, the Board directed the Examiner to consider whether Maguire's statement concerning eliminating the need for pins to determine whether it is a teaching away, citing *In re Gurley*, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994). Judge Newman observed in *Gurley*, "The nature of the resin is the only significant difference from the prior art circuit material. ... The facts in *Gurley*'s record are that this use of epoxy was known, the structure of these circuit boards was known, and epoxy had been used for *Gurley*'s purpose." *Id.*, 1131, 1132 (emphasis supplied). As pointed out in the remarks *supra*, there are several significant differences between Dawson and Maguire, and between these references or any combination of these references and the presently claimed invention, that support Applicants' position that Maguire does indeed teach away from the presently claimed invention.

In *Gurley*, "[t]he Board recognized Yamaguchi's teaching of the deficiencies of epoxy-impregnated material, but observed that Gurley did not distinguish his epoxy product from the product described by Yamaguchi." *Id.*, 1132. In the remarks above, Applicants have distinguished the presently claimed

Amendment and Response

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invention from the disclosure of Maguire by enumerating the multiple structural and functional distinctions there between.

Accordingly, Maguire's statement concerning eliminating the need for pins, as well as Maguire's disclosure as a whole, is indeed a teaching away from Dawson and from the presently claimed invention.

If any additional fees are due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 16-2312. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our deposit account.

Respectfully submitted,

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